

REMARKS

Applicant thanks Examiner Randall for his careful review of the pending claims. In this Amendment and Response, Applicant has amended claims 1, 9, and 24 and has added new claims 26-28. No claims have been canceled. Thus, claims 1, 9-11, and 20-28 remain pending.

Rejection of Claims 1, 9-11, and 19 Under 35 U.S.C. § 112, ¶ 6

The Examiner rejected claims 1, 9-11, and 19 under 35 U.S.C. § 112, ¶ 6 for allegedly failing to clearly link the “means for automatically stopping rotation of said shaft” limitation of claim 1 to corresponding structure in the specification. As amended, claim 1 no longer recites the means clause at issue, and the rejection is believed to be moot.

Rejection of Claims 1 and 19 Under 35 U.S.C. § 103(a) Based on Mossler, Schlumpf, Brenner, and Churchman

The Examiner rejected claims 1 and 19 as obvious under 35 U.S.C. § 103(a) based on the combination of Mossler, U.S. Patent No. 444,502, Schlumpf, U.S. Patent No. 4,296,873, Brenner, U.S. Patent No. 3,503,481, and Churchman, U.S. Patent No. 800,702. The rejection is respectfully traversed.

The Examiner contends that with Mossler’s newspaper vending apparatus, “once a consumer retrieves a newspaper from the dispenser in a forward direction the nearest newspaper becomes dispensed to an opposite planar surface of the plate.” Office Action at 4. Applicant respectfully disagrees. The Examiner does not contend that Mossman expressly describes this feature, but instead apparently contends that it is inherent in the operation of the apparatus. However, in Mossler’s apparatus, the newspaper is pulled down and away from the lower most surface of the structure identified as the plate by the Examiner (A5). A user could readily pull the newspaper out of the apparatus and away from plate A5 without ever pulling it to the opposite planar surface of A5. Thus, at best, the rejection is predicated on one possible mode of operation of Mossler. However, such a possibility does not satisfy the legal standard for inherently disclosing the limitation “said nearest bag is thereby dispensed to said opposite planar surface side of said plate.” See *In Re Rijckaert*, 9 F.3d 1531, 1533-1534 (Fed. Cir. 1993) (reversing the Board’s

obviousness rejection of Applicant's claims on the grounds that a claimed relationship between time expansion/compression and three variables was not inherent in the prior art).

Moreover, even if the Examiner's characterization of Mossler were correct, as amended, claim 1 clearly distinguishes the manual intervention that would be required in order for Mossler to function as the Examiner contends. Claim 1 recites "when said rotatable shaft rotates, said nearestmost bag is thereby dispensed to said opposite planar surface side of said plate." The rotation of Mossler's shaft causes newspapers to be dispensed downward and parallel to Mossler's bag-supporting surface. Neither Schlumpf, Brenner, nor Churchman compensate for Mossler's deficiencies. Thus, claim 1 is allowable over the references of record, and reconsideration and withdrawal of the rejection are requested. Claim 19 depends from claim 1 and is similarly allowable over the references of record.

Rejection of Claims 9 and 10 Under 35 U.S.C. § 103(a) Based on Mossler, Schlumpf, Brenner, Churchman, and Coleman

Claim 9 depends from claim 1 and further recites a second rotatable shaft mounted parallel to said rotatable shaft on an extension of said frame. At least one roller is non-rotatably affixed to the second shaft, and each roller on the rotatable shaft is coupled to a roller on the second rotatable shaft such that rotation of the rotatable shaft causes concomitant rotation of the second rotatable shaft. Claim 10 depends from claim 1 and recites a bag-retaining bar for engaging and retaining said stack of bags.

Coleman does not compensate for the deficiencies of Mossler, Schlumpf, Brenner, and Churchman, noted above. For that reason alone, claims 9 and 10 are allowable over the cited references. Moreover, claim 9 recites that the second rotatable shaft is mounted "on an extension of said frame." Coleman's shaft 73 and shaft 71 are mounted to the same sidewalls of housing 17, not to an extension of a frame:

Each respective shaft member is fixedly and rotatably mounted within a respective first and second wall portion identified by locations (71a,71b), (73a,73b), (75a,75b) and (77a,77b). Also shown therein, are a plurality of conically shaped protrusions 70a peripherally disposed about the surface of the roller 70 and along its length for attaching to and transporting a single napkin in sequence.

Coleman at ¶ 55.

Moreover, as amended, claim 9 recites that said rotatable shaft is disposed between the second rotatable shaft and the bag retaining element. In Coleman's device both dispenser elements 70 and 72 are in contact with the napkins being dispensed and are not oriented in the manner recited in claim 9.

Further, one of ordinary skill in the art would not have been motivated to combine Coleman with Mossler and the other cited references in the manner suggested by the Examiner. Coleman is directed to a napkin dispenser, and Mossler is directed to a newspaper dispenser. The Coleman embodiment on which the Examiner relies, FIG. 7, is directed to commercial restaurant applications where rapid dispensing of napkins is necessary--a feature not required from a newspaper dispenser:

This particular embodiment 11 is specially configured for **commercial use in restaurants and the like which require an increased napkin supply or capacity** as compared to the domestic use of the first embodiment 10.

Mossler at ¶ 55 (emphasis added). The Examiner contends that one of ordinary skill would have been motivated to combine Coleman with the other cited references because "they are within the same art one of ordinary skill ion [sic:in] the art looking for a commercial or public use dispenser would see the combination as a way to increase the efficiency of the dispenser." However, a newspaper dispenser simply does not have the efficiency needs of a commercial restaurant napkin dispenser. Thus, Applicant submits that one skilled in the art would not have been motivated to make the proposed combination.

Rejection of Claim 11 Under 35 U.S.C. § 103(a) Based on Mossler, Schlumpf, Brenner, Churchman, Coleman, and Hawley

The Examiner rejected claim 11 as obvious under 35 U.S.C. § 103(a) over the combination of Mossler, Schlumpf, Brenner, Churchman, Coleman, and Hawley, U.S. Patent No. 1,988,732. The rejection is respectfully traversed.

Claim 11 depends from claim 10. Hawley does not compensate for the deficiencies of Mossler, Schlumpf, Brenner, Churchman, and Coleman, noted above. Nor does Hawley disclose or suggest the additionally recited features of claim 11. Claim 11 recites that "said bag-retaining bar is

coupled to an arm pivotally coupled to said plate.” In claim 11, the arm is pivotally coupled to the same plate that includes the planar bag supporting surface. Hawley discloses a different structure wherein, as the Examiner acknowledges, arm 42 is coupled to a “rear wall” not to the shelf-member 19a that supports the towels. None of the references of record suggest pivotally coupling a bag-retaining element to a planar bag-supporting surface. Thus, even if--as the Examiner contends--Hawley provides an “alternative means for biasing a stack” it does not provide the arm-plate structure recited in claim 11.

Rejection of Claim 20 Under 35 U.S.C. § 103(a) Based on Mossler and Schlumpf

The Examiner rejected claim 20 as obvious under 35 U.S.C. § 103(a) based on the combination of Mossler and Schlumpf. The rejection is respectfully traversed.

Claim 20 recites, *inter alia*, “dispensing one bag from said stack of bags nearest said planar bag-supporting surface to said opposite planar surface of said plate *by rotating said rotatable shaft*.” The Examiner’s analysis attempts to disaggregate this claim limitation by suggesting that a user of Mossler’s device can move a paper to the “opposite planar surface” of Mossler’s plate *after* Mossler’s device dispenses the newspaper. However, it is clear that upon rotating Mossler’s rotatable shaft B, the newspaper is merely dispensed downward and away from plate A5, not to the opposite planar surface of the plate. Thus, Mossler and Schlumpf fail to disclose or suggest the “dispensing” limitation of claim 20.

Moreover, claim 20 recites “automatically stopping rotation of said shaft after dispensing said *nearest* one bag.” In Brenner’s device, rotation is stopped after dispensing the bag that is *furthest* from the bag-supporting surface. For this reason as well, claim 20 is distinguishable over the references of record.

Schlumpf does not compensate for Mossler’s deficiencies. Thus, claim 20 is allowable over the cited references. Reconsideration and withdrawal of the rejection are respectfully requested.

Rejection of Claims 21-23 Under 35 U.S.C. § 103(a) Based on Mossler, Schlumpf, and Brenner

The Examiner rejected claims 21-23 as obvious under 35 U.S.C. § 103(a) based on the combination of Mossler, Schlumpf, and Brenner.

Claims 21-23 depend from claim 20. Brenner does not compensate for the deficiencies of Mossler and Schlumpf, noted above. Thus, claims 21-23 are allowable over the cited references.

Rejection of Claims 24 and 25 Under 35 U.S.C. § 103(a) Based on Mossler, Schlumpf, and Coleman

The Examiner rejected claims 24 and 25 as obvious under 35 U.S.C. § 103(a) based on the combination of Mossler, Schlumpf, and Coleman. Claims 24 and 25 depend from claim 20. Coleman does not compensate for the deficiencies of Mossler and Schlumpf, noted above. For this reason alone, claims 24 and 25 are allowable over the references of record.

In addition, as amended, claim 24 recites that the rotatable shaft is disposed between the second rotatable shaft and the one bag being dispensed. Neither Coleman nor the other references of record disclose or suggest this feature.

New Claims 26-28

Claim 26 depends from claim and recites additional features of the bag retaining element. Claim 27 depends from claim 26 and further recites that the bag-retaining element is biased toward a closed orientation with respect to the plate. Claim 28 recites limitation similar to claims 26 and 27. The additional features of claims 26-28 further distinguish the references of record.

CONCLUSION

In view of the above amendments and remarks it is respectfully submitted that the claims are in condition for allowance. Re-examination and allowance are, therefore, respectfully solicited. In the event the Examiner deems that outstanding issues remain, he is respectfully requested to telephone the undersigned attorney in an effort to resolve such issues.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 66599-0005 from which the undersigned is authorized to draw.

Dated: August 5, 2009

Respectfully submitted,

By /Steven R. Hansen/

Steven R. Hansen

Registration No.: 39,214

RADER, FISHMAN & GRAUER PLLC

Correspondence Customer Number: 10291

Attorney for Applicant